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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,106	03/15/2000	Robert F. Balint	PARE.002.01US	9164

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EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 06/17/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

File Copy

Application No.

09/526,106

Applicant(s)

BALINT ET AL.

Examiner

Jon D Epperson

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

SUPPLEMENTAL RESTRICTION

Please Note: There is a change in Examiner handling prosecution in the current case from Examiner Thomas Friend to Jon D. Epperson.

1. The Response to Restriction Requirement dated October 17, 2003, is acknowledged (Paper No. 16).
2. As an initial matter, please note that in preparing this Supplemental Restriction Requirement the Examiner noted a problem with claim 24. Claim 24 is drawn as a "method" (see claim 24, "The method according to claim 23"), but depends on claim 23 that is drawn to a product (see claim 23, "A fragment complementation system"). The Examiner has interpreted claim 24 to be "The fragment complementation system according to claim 23" for purposes of restriction. It would assist the further examination of this case on the merits if applicant could correct and/or address this problem in the Response to this action. If claim 24 is drawn to a "method" it will be withdrawn from further consideration and will not be treated on the merits. See 37 CFR 1.75(c).
3. In addition, upon further review of applicants' claims, an additional restriction and/or election of species was deemed necessary (see below).

Election/Restriction

4. Upon review of the instant case, the application was deemed to contain claims directed to patentably distinct species of the claimed invention. Election from the following species is

Art Unit: 1639

required. Note: applicant must elect *one* species from *each* subgroup below. Claim 22 is generic

Subgroup 1: Species of linker (see claim 25)

Applicant must elect, for the purposes of search, a single species of linker e.g., (Gly₄Ser)₃.

Subgroup 2: Species of first interactor domain (see claim 25)

Applicant must elect, for the purposes of search, a single species of first interactor domain e.g., c-Fos (see table 5).

Subgroup 3: Species of second interactor domain (see claim 25)

Applicant must elect, for the purposes of search, a single species of second interactor domain e.g., c-Jun (see table 5).

Subgroup 4: Species of signal peptide (see claim 26)

Applicant must elect, for the purposes of search, a single species of signal peptide (see specification).

Subgroup 5: Species of enhancement (see claim 28)

Applicant must elect, for the purposes of search, a single species of enhancement e.g., e.g., addition of Asn-Gly-Arg (NGR) to α 197.

5. **Please note:** applicant must indicate which claims read on the elected species above (see paragraphs 7-8 below).
6. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. For different species of method, the method steps for each species would differ. Moreover, the above species can be separately classified. Consequently, the species have

Art Unit: 1639

different issues regarding patentability and represent patentably distinct subject matter.

Therefore, this does create an undue search burden, and election for examination purposes as indicated is proper.

7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

8. Applicant is advised that a reply to this requirement **must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered **nonresponsive** unless accompanied by an election.

9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, **applicant must indicate which are readable upon the elected species.** MPEP § 809.02(a).

10. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 1639

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

13. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

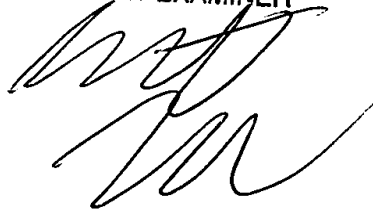
Art Unit: 1639

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D. Epperson, Ph.D. whose telephone number is (703) 308-2423. The examiner can normally be reached on Monday-Friday from 9:00 a.m. to 6:00 p.m.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Jon D. Epperson, Ph.D.
June 15, 2003

BENNETT CELSA
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Bennett Celsa', is written over the printed name and title.